



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,036	07/07/2006	Konstantin Lutze	BR P1002 US	5094

37138 7590 01/12/2010
THADDIUS J. CARVIS
102 NORTH KING STREET
LEESBURG, VA 20176

EXAMINER

REIFSNYDER, DAVID A

ART UNIT	PAPER NUMBER
----------	--------------

1797

MAIL DATE	DELIVERY MODE
-----------	---------------

01/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,036	Applicant(s) LUTZE, KONSTANTIN	
	Examiner David A. Reifsnnyder	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The specification is objected to because the because the abstract of the disclosure is too long. Correction is required. See MPEP § 608.01(b). The new abstract should be on a separate sheet of paper and have between 50 and 150 words.

Drawings

There are no drawings in this case. Furthermore, if the drawings from the priority document or PCT or used there is still a problem, since those drawings are clearly **Informal**. In response to this office action, **Formal Drawings are Required**.

The requirement for Formal Drawings **will not** be held in abeyance .

Claim Objections

Claims 4-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim numbers 4-16 have not been further treated on the merits.

Furthermore, claims 9-10 depend from claims 1-8 and it is unsure as to whether the applicant is trying to claim device, container and a membrane or simply a container and membrane. The applicant needs to write claim 9 as an independent claim. The applicant needs to be aware that when he does that the possibility exists that claims 9-

Art Unit: 1797

10 **will be restricted by original presentation of the invention,** since the applicant is getting an action on the merits for a device (10) with this action. Lastly, the applicant should write his amended claims 9-10 carefully so as to avoid any 35 USC 112, 2nd paragraph problems.

In addition, claims 11-16 depend from claims 1-10 and it is unsure as to whether the applicant is improperly trying to claim a method and device and/or a method, device, container and membrane. The applicant needs to write claim 11 as an independent claim. The applicant needs to be aware that when he does that the possibility exists that claims 11-16 **will be restricted by original presentation of the invention,** since the applicant is getting an action on the merits for a device (10) with this action. Lastly, the applicant should write his new claims 11-16 carefully so as to avoid any 35 USC 112, 2nd paragraph problems.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3; the recitation in claim 1 of “characterized” would normally be interpreted as meaning “comprising”; however, since comprising is already recited in

Art Unit: 1797

this claim, it is vague and indefinite as to what is meant by "characterized". Furthermore, it is unclear as to whether a Jepson type format is intended. (see C.F.R 1.75(e))

Regarding claim 1; the recitation in the preamble of "in particular molecular biological or biochemical substances" is vague and indefinite as to whether "molecular biological or biochemical substances" are being positively claimed. Also, the recitation in the preamble of "for the automatic separation of the solid and liquid phase of a suspension and for purifying magnetic microparticles" is confusing since the body of the claim fails to claim any separation or purifying steps and/or structure. Also, the recitation of "for transporting the magnetic microparticles" is vague and indefinite as to how the magnetic particles are transported without some sort of container.

Furthermore, the plural recitation of "guides" in the recitation of "second guides" is confusing and can not be understood. Also, the recitation of "for supplying reagent containers (R)" followed by the recitation of "the reagent containers (R)" is vague and indefinite as to whether the "reagent containers (R)" are being positively claimed.

Furthermore, the recitation of "for magnetic or magnetizable transfer elements (28) which are arranged in a matrix shape" can not be understood and it is unclear as to whether transfer elements are being claimed or not. In addition, the recitation of "the grid of the transfer elements (28)" lacks antecedent basis. **Lastly, because of these issues and the fact that claim 1 is written with numerous grammatical issues, the entire claim 1 is vague and indefinite, confusing and hard if not impossible to understand.**

Art Unit: 1797

Regarding claim 2; the recitation of “in that the transfer elements (28) are configured as preferably rod-shaped permanent magnets or electromagnets” is vague and indefinite because transfer elements (28) where not clearly claimed in claim 1, and it is also vague and indefinite as to whether “rod-shaped permanent magnets or electromagnets” are being positively claimed.

Regarding claim 3; the recitation of “the lowermost part” lacks antecedent basis. Furthermore, the two recitations of “the transfer elements (28)” are vague and indefinite, because transfer elements (28) where not clearly claimed in claim 1. Furthermore the recitation of “dipping into the sample (P)” can not be understood. In addition, the recitation of “the sample (P)” lacks antecedent basis. Also the recitation of “reagent containers (R)” is vague and indefinite as to whether they are the same reagent containers as the ones discussed in claim 1. Furthermore, even if the “reagent containers or the same ones as discussed in claim 1, that recitation is vague and indefinite because reagent containers where not clearly claimed in claim 1. Also, the recitation of “is covered by a membrane (M)” can not be understood and it is vague and indefinite as to whether a membrane is being positively claimed. Also, the recitation of “a membrane (M)...preferably tubular or beaker-shaped” is vague and indefinite as to whether a tubular or beaker shaped membrane (M) is being positively claimed. **Lastly, because of these issues and the fact that claim 3 is written with numerous grammatical issues, the entire claim 3 is vague and indefinite, confusing and hard if not impossible to understand.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 03/090897 who discloses an automated system for separating magnetic particles suspended in a fluid as discussed on page 51 line 24 to page 56 line 8.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Meltzer who discloses an automated pipetting system for performing programmed pipetting procedures on an array of test tubes comprising; frame assembly (10) comprising sub frame assembly (13) which includes a carriage (14) which holds probes (15), the frame (10) and subframe assembly (13) transporting the carriage (14) and probes (15) in the x, y and z directions. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. ***Kropa v. Robie, 88 USPQ 478 (CCPA 1951).***

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Reifsnyder whose telephone number is (571) 272-1145. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David A Reifsnyder/
Primary Examiner, Art Unit 1797